

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ramkumar Mandalam et al.

Filing Date: March 26, 2004

Serial No: 10/810,311

Title: PROTOCOLS FOR MAKING
HEPATOCYTES FROM EMBRYONIC
STEM CELLS

Art Unit: 1632

Examiner: Thaian N. Ton

Confirmation No. 8003

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. § 1.705(d) and in view of the recent ruling in Wyeth v. Dudas (Docket No. 1:07-cv-01492-JR, Opinion dated September 30, 2008) in the District Court for the District of Columbia, Applicant submits this Request for Reconsideration in the calculation of the Patent Term Adjustment (PTA).

The request is timely filed because: 1) the patent issued on January 6, 2009, thus this request for reconsideration of the PTA is filed within two months of issuance; and 2) the request is based in part on the ruling in Wyeth, supra.

At the time of issuance, the Office calculated the PTA at 584 days. However, in view of the holding in Wyeth v. Dudas, Applicant has recalculated the PTA to be 1211 days.

The additional 627 days is calculated as follows. The application was filed on March 26, 2007, claiming priority as a continuation-in-part of US Appl. No. 10/087,142.

The first office action was mailed on April 20, 2007. With the 14 month grace period, that leaves a difference of 694 days (as calculated by the Office) after the application was filed. The Office accrued an additional 13 days for failing to act within four months of Applicants response to an Office Action. No terminal disclaimers were filed in this case. According to the Office's calculations, Applicants total time of delay (37 C.F.R. § 1.704) is 123 days, and is not disputed. Subtracting the 123 days for Applicants failure to timely prosecute this case, the PTO concludes Applicants are entitled to 584 days of added term. But the PTO has ignored the fact that the application, which was filed on March 26, 2004, should have issued on March 26, 2007, according to the 3-year pendency rule. Thus according to Wyeth supra, Applicants believe they are also entitled to the period from the three-year deadline (March 26, 2007) to the issuance date (January 6, 2009). Subtracting the portion of this period that overlaps with the 14-month adjustment already accounted for (i.e., the difference between the 3-year deadline (March 26, 2007) and the date the first office action was mailed (April 20, 2007), which is 25 days, Applicants believe they are entitled to an additional 627 days of patent term.

Therefore, Applicant requests the PTA be amended to reflect the correct PTA under Wyeth: 1211 days.

The fee of \$200 is attached herewith. Should the Patent Office determine that additional fees or other relief is required, Applicant authorizes the Commissioner to charge Deposit Account No. 07-1139, referencing the docket number above.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "E. Stewart Mittler".

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